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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/084,697 07/06/99 GRUBER

V 855-15

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EXAMINER

BUI, P

ART UNIT

PAPER NUMBER

1638

DATE MAILED:

9  
12/19/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/284,697

Applicant(s)

Gruber et al.

Examiner

Phuong Bui

Group Art Unit

1638



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-26 is/are pending in the applicant

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-26 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_, is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## DETAILED ACTION

### *Election/Restrictions*

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1, 2, 5, 6, 9, 11, 12, drawn to a polynucleotide and method of using it for expressing pancreatic lipase.

Group II, claim(s) 1, 3, 5, 7, 9, 11, 13, drawn to a polynucleotide and method of using it for expressing colipase.

Group III, claim(s) 4, 8, 9, 14, drawn to a polynucleotide and method of using it for expressing pancreatic lipase and colipase.

Group IV, claim(s) 10, drawn to a bacterial host cell transformed with pancreatic lipase DNA.

Group V, claim(s) 10, drawn to a bacterial host cell transformed with colipase DNA.

Group VI, claim(s) 10, drawn to a bacterial host cell transformed with pancreatic lipase and colipase DNA.

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Group VII, claim(s) 15, 20, 21, 23, 25, drawn to a plant transformed with pancreatic lipase DNA and a method of treating lipase deficiency disorders.

Group VIII, claim(s) 15, 20, 21, 23, 25, drawn to a plant transformed with colipase DNA and a method of treating lipase deficiency disorders.

Group IX, claim(s) 15, 20, 21, 23, 25, drawn to a plant transformed with pancreatic lipase and colipase DNA and a method of treating lipase deficiency disorders.

Group X, claim(s) 16, 19, 20, 21, 23, 25, drawn to recombinant pancreatic lipase and a method of treatment of lipase deficiency disorder.

Group XI, claim(s) 17, 19, 20, 21, 23, 25, drawn to recombinant colipase and a method of treatment of lipase deficiency disorder.

Group XII, claim(s) 18-21, 23, 25, drawn to recombinant pancreatic lipase-colipase complex and a method of treatment of lipase deficiency disorder.

Group XIII, claim(s) 20, drawn to a method of treatment of an eating disorder with a recombinant pancreatic lipase-colipase complex.

Group XIV, claim(s) 20, drawn to a method of treatment of an eating disorder with a recombinant pancreatic lipase.

Group XV, claim(s) 20, drawn to a method of treatment of an eating disorder with a recombinant colipase.

Group XVI, claim(s) 20, drawn to a method of treatment of an eating disorder with a plant transformed with pancreatic lipase DNA.

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Group XVII, claim(s) 20, drawn to a method of treatment of an eating disorder with a plant transformed with colipase DNA .

Group XVIII, claim(s) 20, drawn to a method of treatment of an eating disorder with a plant transformed with pancreatic lipase-colipase complex DNA.

Group XIX, claim(s) 22, drawn to a method of obtaining food using a plant transformed with pancreatic lipase-colipase complex DNA.

Group XX, claim(s) 22, drawn to a method of obtaining food using a plant transformed with pancreatic lipase DNA.

Group XXI, claim(s) 22, drawn to a method of obtaining food using a plant transformed with colipase DNA .

Group XXII, claim(s) 22, drawn to a method of obtaining food using pancreatic lipase-colipase complex.

Group XXIII, claim(s) 22, drawn to a method of obtaining food using pancreatic lipase.

Group XXIV, claim(s) 22, drawn to a method of obtaining food using colipase.

Group XXV, claim(s) 24, drawn to a method of implementing enzymatic reactions using a plant transformed with pancreatic lipase-colipase complex DNA.

Group XXVI, claim(s) 24, drawn to a method of implementing enzymatic reactions using a plant transformed with pancreatic lipase DNA.

Group XXVII, claim(s) 24, drawn to a method of implementing enzymatic reactions using a plant transformed with colipase DNA .

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Group XXVIII, claim(s) 24, drawn to a method of implementing enzymatic reactions using pancreatic lipase-colipase complex.

Group XXIX, claim(s) 24, drawn to a method of implementing enzymatic reactions using pancreatic lipase.

Group XXX, claim(s) 24, drawn to a method of implementing enzymatic reactions using colipase.

Group XXXI, claim(s) 26, drawn to a method obtain biofuels using a plant transformed with pancreatic lipase-colipase complex DNA.

Group XXXII, claim(s) 26, drawn to a method obtain biofuels using a plant transformed with pancreatic lipase DNA.

Group XXXIII, claim(s) 26, drawn to a method obtain biofuels using a plant transformed with colipase DNA.

Group XXXIV, claim(s) 26, drawn to a method obtain biofuels using pancreatic lipase-colipase complex DNA.

Group XXXV, claim(s) 26, drawn to a method obtain biofuels using pancreatic lipase DNA.

Group XXXVI, claim(s) 26, drawn to a method obtain biofuels using colipase DNA.

2. The inventions listed as Groups I-XXXVI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

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These inventions relate to DNA, polypeptides, plants and methods of using these molecules. The DNA and polypeptides lack the same or corresponding special technical feature in that each group is directed to molecules that are structurally and chemically different from each other. Each group is capable of uses that the other is incapable of. For example, the DNA can be used, not only for expression of the protein, but for hybridization assays or in an amplification process. The protein is also capable of being used in an assay independent of the DNA and is also capable of use in various processes as evidenced by the different methods of use claimed. Each of the first recited methods of use has been grouped with its respective product claim group in accordance with PCT Rules. Finally, the claims have further been grouped to account for the fact that lipase, colipase and the lipase-colipase complex each represent different general inventive concepts. Again, these molecules are structurally and functionally different and are capable of use separately, as evidenced by the claims.

3. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).
4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

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5. Papers relating to this application may be submitted to Technology Sector 1 by facsimile transmission. Papers should be faxed to Crystal Mall 1, Art Unit 1638, using fax number (703) 308-4242. All Technology Sector 1 fax machines are available to receive transmissions 24 hrs/day, 7 days/wk. Please note that the faxing of such papers must conform with the Notice published in the Official Gazette, 1096 OG 30, (November 15, 1989).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuong Bui whose telephone number is (703) 305-1996. The Examiner can normally be reached Monday-Friday from 6:30 AM - 4:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Paula Hutzell, can be reached at (703) 308-4310.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is (703) 308-0196.

Phuong Bui  
Primary Examiner  
Group Art Unit 1638  
December 15, 2000

*Phuong Bui*  
PHUONG T. BUI  
PRIMARY EXAMINER